

Remarks

At the time of the Office Action, which was made Final, claims 7-24 were pending. Claims 7-24 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,167,469 to Safai et al. (hereinafter Safai) in view of U.S. Patent No. 5,555,194 to Cok (hereinafter Cok). Furthermore, claims 7, 19 and 22 stand rejected under 35 U.S.C. § 112 second paragraph as being indefinite.

In the present response claims 7, 9, 19 and 22 are amended and the balance of claims remain unchanged. It is submitted that the amendments to claims 7, 9, 19 and 22 require only a cursory review by the Examiner because the amendments do not necessitate a further search. To this end, the Applicant respectfully requests entry of the present response since it is being submitted in accordance with 37 CFR 1.116 to place the application in form for allowance or better form for appeal.

The Applicant respectfully requests reconsideration in view of the remarks that follow.

As an initial matter, the Office Action indicates on Page 3 of the Detailed Action (Item 3) that claim 23 is rejected under 35 U.S.C. § 112 second paragraph. The Applicant believes that this is a typographical error because claim 23 does not recite the term “substantially.” Accordingly, the present response is submitted according to the Applicant’s understanding that the Office Action meant to reject claim 22 and not claim 23.

No new matter is introduced by way of the present amendments to claims 7, 9, 19 and 22. In particular, claim 9 is amended to correct a clerical error, whereas claims 7, 19 and 22 are amended to delete the term “substantially” that modified the terms similar and surrounding. Accordingly, the Applicants submit that the amendments are made for reasons unrelated to patentability and respectfully request entry of the present response.

In the Office Action claims 7, 19 and 22 stand rejected under 35 U.S.C. § 112 second paragraph. The Applicant traverses this rejection and respectfully disagrees with the contention in the Office Action that the terms “substantially similar” and “substantially surrounding” are unclear. In support of the Applicant’s position, the Applicant points to MPEP 2173.05(b), paragraph D which states,

“The term "substantially" is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). The court held that the limitation "to substantially increase the efficiency of the compound as a copper extractant" was definite in view of the general guidelines contained in the specification. *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in the art would know what was meant by "substantially equal." *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988).”

According to the foregoing and MPEP 2173.04, which states, “Breadth of a claim is not to be equated with indefiniteness.” the Applicant submits that that the terms “substantially similar” and “substantially surrounding” are not indefinite. Nevertheless, to advance prosecution of the application, claims 7, 19 and 22 are amended to delete the term “substantially.” In view of these amendments the Applicant respectfully requests that the 35 U.S.C. § 112 second paragraph rejection of claims 7, 19 and 22 be withdrawn.

Turning now to claim 7, the Office Action states that Safai discloses a method for retouching a photographed image (col. 7, lines 31-50) wherein the retouching method includes a step of expanding/magnifying (col. 10, lines 60-67) a displayed image that is to be retouched. The Applicant points out that column 10, lines 60-67 of Safai only discloses a zoom button or icon that enables a user to zoom in on a portion of an image being displayed. As such, Safai discloses a well-known function of conventional digital cameras, not that Safai’s camera performs retouching on a magnified image. Although Safai discloses the functions of retouching and zooming being completely separate, distinct and altogether unrelated to each other (in fact, Safai is completely silent as to how Safai’s camera performs a retouching operation), still the Office Action on Page 2 states that a person of ordinary skill would have considered the Applicant’s method to be obvious in view of Safai and Cok because Safai suggests the combination of these two distinct functions by mere mention in the same reference. By logical extension of the Examiner’s erroneous contention, the Applicant submits that Safai would also suggest applying a retouching operation to a thumbnail-sized image because Safai discloses displaying images in thumbnail form (col. 10, lines 35-40). However, it is completely nonsensical to apply retouching to a thumbnail-sized image because such images generally have low resolution or quality.

The Applicant disagrees with the Office Action's position and submits that the Office Action's contention (i.e., that Safai suggests a retouching operation that includes expanding/magnifying an image) is pure speculation or supposition on the Examiner's part that amounts to wishful thinking. In fact, the Applicant has reviewed Safai in its entirety and can find no explicit or implied suggestion for a retouching operation that includes expanding/magnifying an image. Furthermore, it is noteworthy that Cok, which is cited specifically to provide various details/steps of a pixel-copying/cloning retouching operation, does not disclose, show, teach, suggest or contemplate that an expanding/magnifying operation could be included in a retouching operation. In view of the foregoing remarks, the Applicant submits that the rejection of claim 7 is specious and, therefore, that claim 7 is allowable. Furthermore, the Applicant submits that claim 19 is allowable as well vis-à-vis the foregoing remarks concerning the rejection of claim 7.

Turning now to the rejections of claim 9 and claims 10-18 that depend directly or indirectly from claim 9, the Applicant again traverses these rejections and submits the following remarks. In the Applicant's previous response it was submitted that the Examiner failed to point out where any of the expressly recited structural features of claims 9-18 are disclosed, taught, suggested or contemplated in Safai and/or Cok. Although Page 2 of the Office Action provides one clue as to what disclosure of Safai (i.e., elements 210, 232 shown in FIG. 2 of Safai) is considered to read on the Applicant's structural features recited in claim 9, the Office Action still fails to provide any detail as to where the structural features recited in claim 11 (i.e., a filter window forming unit, a filter window moving unit, a region copying unit and a color information substituting unit) as well as the structural features recited in claims 13-18 can be found in the applied art references.

According to MPEP 707.07(f), "In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application." MPEP 707.07(f) further states, "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Because the Office Action does not answer, or even indicate consideration of, the Applicant's arguments traversing the rejection of claims 11 and 13-18, the Applicant respectfully requests that the Office withdraw the finality of the Office Action and issue a new action in view of MPEP 707.07(f) to provide a complete application file history and to enhance the clarity of the prosecution history record.

Nevertheless, although the Office Action points to elements 210 and 232 (shown in FIG. 2 of Safai) as reading on the region recognition unit and region retouch unit of claim 9, the Applicant submits that the Office Action has not considered nor treated on the merits the language of claim 9 that recites, "wherein the region recognition unit and the region retouch unit are located on the digital camera." The Applicant submits that this wherein clause further defines the structure of the apparatus of claim 9. However, the Examiner has completely ignored this language contrary to MPEP 2111.04.

According to MPEP 2143.03, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, MPEP 2143.03 states, "***All words in a claim must be considered*** in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." (emphasis added) Since the Office Action has not considered all words in claims 9-18, particularly the wherein clause of claim 9, the Applicant submits that the Office has not established *prima facie* obviousness of the claims and requests withdrawal of the rejection of claims 9-18.

The application is considered in good and proper form and the Applicant respectfully requests favorable reconsideration. However, if the Examiner maintains the finality of the rejections, the Applicant stands ready to appeal. If, in the opinion of the Examiner, a telephone conference would help resolve any issues that remain, the Examiner is invited to call the undersigned.

Respectfully submitted,

/brian c. rupp/

Brian C. Rupp, Reg. No. 35,665
David R. Morris, Reg. No. 53,348
DRINKER BIDDLE & REATH LLP
191 N. Wacker Drive, Suite 3700
Chicago, Illinois 60606-1698
(312) 569-1000 (telephone)
(312) 569-3000 (facsimile)
Customer No.: 08968

Date: January 14, 2008